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09/818,851	03/28/2001	Susumu Yoshiwara		9525

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EXAMINER

GLESSNER, BRIAN E

ART UNIT	PAPER NUMBER
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3635

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/818,851
Filing Date: March 28, 2001
Appellant(s): YOSHIWARA ET AL.

Clyde I. Coughenour
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 16, 2004.

Art Unit: 3635

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The statement pertaining to the grouping of the claims is acknowledged.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 3635

(9) Prior Art of Record

1,487,578

KIRKPATRICK

3-1924

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The rejections of claims 1 and 14-16 under 35 U.S.C. 112, 2nd paragraph are hereby withdrawn in view of appellant's remarks filed with the appeal brief.

Claim Rejections - 35 USC § 103

1. Claims 1, 8-13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirkpatrick (1,487,578).

In regard to claim 1, Kirkpatrick discloses a structure comprising a construction block A having an upper surface and a lower surface and side surfaces (the surfaces are as oriented in figure 1), aggregate pieces, i.e. crushed rock or the like, line 43, within said block lower extent adjacent to said lower surface and forming the major extent of said lower surface, said aggregate pieces each having a circumference and being in direct firm contact with one another, said aggregate pieces extending from and between said construction block sides (the chamfered portions are part of the sides of the block), said aggregate pieces being held in contact with each other by mortar above said aggregate pieces, lines 43-46 and figure 1 shows the aggregate pieces in firm contact, so that said construction block is capable of providing a strong support for vertical forces applied to said upper surface and a strong resistance to horizontal vibrations of an earthquake applied to said side surfaces by transfer forces directly from one aggregate piece to another through said construction block. Kirkpatrick does not specifically disclose that said circumferences are in excess of 5 cm. It would have been obvious to one having ordinary skill in

Art Unit: 3635

the art at the time the invention was made to use aggregate pieces having circumferences in excess of 5 cm because said pieces will create firm contact between the aggregate pieces in order to transfer vibrations.

Finally, although Kirkpatrick does not specifically disclose that said blocks are “earthquake resistant structures”, the examiner would like to point out that these limitations are found in the preamble of the claim, and a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. In the instant case, the preamble of the claim merely recites how the structure is to function and the structure of the block is capable of standing on its own.

In regard to claims 8, 9, 11 and 12, Kirkpatrick discloses the basic claimed invention except for specifically disclosing that said aggregate pieces are of a low quality material, or slag, or concrete chips, or Sirasu. However, Kirkpatrick does disclose that said aggregate could be “crushed rock or the like”, line 43. Further, the examiner would like to point out that the above aggregates are notoriously well known in the prior art by those having ordinary skill for being used with concrete structures. Therefore, the phrase “or the like” in Kirkpatrick’s disclosure would be interpreted by one having ordinary skill in the art as including the above aggregates since they are so widely used in the concrete art.

In regard to claim 10, Kirkpatrick discloses the basic claimed invention, wherein said aggregate pieces are crushed stone, i.e. crushed rock.

Art Unit: 3635

In regard to claim 13, Kirkpatrick discloses a process for forming construction blocks A comprising providing a mold having an upper extent and a lower extent in the desired shape of a construction block, placing aggregate pieces having a circumference within said mold lower extent, positioning said aggregate pieces within said mold lower extent so that said aggregate pieces are in firm contact with said mold sides and in firm contact with each other throughout said mold to form a lower surface, pouring mortar over said positioned aggregate pieces so as to maintain their position and form an upper surface and form a block having a strong resistance to vertical forces applied to said upper surface and a resistance to horizontal vibrations of an earthquake by transferring forces applied directly from one aggregate piece to another, removing said block from said mold, lines 43-57 and figure 1 shows the aggregate pieces in firm contact. Kirkpatrick does not specifically disclose that said circumferences are in excess of 5 cm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use aggregate pieces having circumferences in excess of 5 cm because said pieces will create firm contact between the aggregate pieces in order to transfer vibrations.

The examiner would further like to point out that the mold obviously has an upper and lower extent in the desired shape of a construction block, and mold sides in contact with said aggregate. This is so because in order for the mold to hold the aggregate and cement, it must have sides to prevent the cement and aggregate from spilling out onto a flat surface. Further, since the chamfered portions of the block are part of the sides of the block, and the aggregate is on part of the chamfered sides, the aggregate was obviously in contact with the side of the form that formed the chamfer.

Art Unit: 3635

In regard to claim 19, Kirkpatrick discloses the basic claimed method except for specifically referring to his aggregate as “low quality material”. Claim 19 contains the same limitation as claimed in claim 8 and is therefore rejected on the same grounds of rejection set forth above in the paragraph pertaining to claims 8, 9, 11, and 12.

(11) *Response to Argument*

In regard to the appellant’s arguments pertaining to the 35 U.S.C. 112, 2nd paragraph rejections of claims 1 and 14-16, the examiner would like to state that these arguments will not be addressed because the examiner is withdrawing said rejections.

The appellant has made the comment that claim 2 has been indicated as being allowable if rewritten in independent form because claim 2 claims two blocks having abutting sides with their aggregate pieces in contact with each other. The examiner has indicated that Kirkpatrick does not show this feature. However, the examiner would like to point out that the chamfered portion is still part of the sides of the blocks even though it angles and the aggregate pieces do not touch when the blocks are stacked. Nowhere in the claim does it state that the side surfaces have to be flat planar surfaces. Further, when looking at a right or left end view of the block in Kirkpatrick’s figure 1, the chamfered surfaces will be seen along with at least a few pieces of the aggregate that is located on the side surfaces. However, from this view the lower surface containing the majority of the aggregate will not be seen because it is not part of the side of the block. Only the side surfaces of the block will be seen when one views said block from the left or right ends, i.e. a side view of the block only shows the side surfaces.

In response to appellant’s argument that Kirkpatrick’s invention and appellant’s inventions are for different purposes, the examiner would like to point out that a recitation of the

Art Unit: 3635

intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, both Kirkpatrick's block and the appellant's block have the same structural features. Therefore, they could both be "used" in the same manner. Also, the intended use recited in appellant's claim does not change the structure of the block in any way.

The appellant also argues the intended use of the aggregate. Appellant argues that Kirkpatrick's aggregate is placed on the front face of the block. However, the examiner would like to point out that claim 1 is only claiming one block. Therefore, said block could be oriented in any manner. If the block of claim 1 were turned 180 degrees, the lower surface would then be the upper surface. Thus, since Kirkpatrick shows his block in figure 1 with the aggregate containing surface facing down, it is being considered to be the lower surface because it is lower than any of the other surfaces. Therefore, since both the appellant's block and Kirkpatrick's block have the aggregate in the lower surface, they will both be capable of functioning in the same manner. Once again, the intended use of the aggregate does not result in a structural difference between the two blocks. Thus, appellant's claim 1 is not patentable over Kirkpatrick.

The appellant further argues that it is the applicant who defines the invention and terms used. The examiner respectfully agrees. However, Kirkpatrick only refers to his side 10 as a veneer face. Where does Kirkpatrick state that his "veneer face" is his front face? The fact is he

Art Unit: 3635

does not make any such statement. Therefore, what is to stop the examiner from referring to the veneer face as a lower surface? The fact is nothing is stopping the examiner from referring to the veneer face as the lower surface for the same reason the appellant can refer to the veneer face as the front face. The appellant is arguing that the examiner is trying to redefine Kirkpatrick's surfaces. However, the examiner is not trying to redefine the surfaces of Kirkpatrick's block. The examiner is merely looking at figure 1 and interpreting the figure with the broadest possible interpretation while staying within reasonable limits and not destroying Kirkpatrick's invention. Since Kirkpatrick does not limit the veneer face to being the front face, the examiner is well within reason to refer to the veneer face as a lower surface. Finally, the examiner also takes the position that the placement of the reinforcing element 16 has nothing to do with what faces are called what.

Next, the appellant argues that the aggregate of Kirkpatrick does not contact the sides of the mold and that it does not extend from and between the sides of the block. The examiner respectfully disagrees. As pointed out above, the chamfers are considered to be part of the sides of the block and not the lower face of the block. Therefore, since it can clearly be seen in figure 1 that the aggregate pieces are at least partially embedded in the sides of the block, they must be in contact with the chamfered side part of the form that formed the side chamfer on the block sidewall. Further, even though the appellant argues the Kirkpatrick's aggregate does not abut each other in firm contact, the examiner respectfully disagrees. The examiner contends that it is clear from Kirkpatrick's figure 1 that the aggregate pieces are in abutting contact with each other. Further, Kirkpatrick even discloses that the rocks are placed in the mold and rocks are placed in the crevices between the rocks. Therefore, all of the rocks would have to be in abutting

Art Unit: 3635

contact with each other. Finally, figure 1 and Kirkpatrick's disclosure clearly show at least the first row of rocks in firm, abutting contact. Even though some of the rocks taper back to form crevices, their forward most surfaces are clearly in contact. Therefore, since the rocks are in contact, any force action on one rock will obviously be transferred to an adjacent rock. Thus, the forces acting on the rocks will be absorbed by all of the rocks.

The appellant also argues that it would not have been obvious to use slag, concrete chips, Sirasu, etc... in Kirkpatrick's invention. The examiner respectfully disagrees. Kirkpatrick even discloses that said aggregate could be "crushed rock or the like", line 43. Further, the examiner would like to point out that the above aggregates are notoriously well known in the prior art by those having ordinary skill for being used with concrete structures. Therefore, the phrase "or the like" in Kirkpatrick's disclosure would be interpreted by one having ordinary skill in the art as including the above aggregates since they are so widely used in the concrete art. Further, the appellant even discloses that these aggregates are known for being used in the past. Thus, it is well within the level of one having ordinary skill to choose a known aggregate from a group of known aggregates.

In response to applicant's argument that Kirkpatrick is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor **or, if not**, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Kirkpatrick block is within the applicant's field of endeavor. Both Kirkpatrick's invention and the appellant's claimed invention are directed to concrete blocks. Their use is not relevant since only one block is being

Art Unit: 3635

claimed. One concrete block could be used in many different applications. One could use the block as a seat to sit on or in a wall to support a roof. Therefore, the use does not define the single block. The structure defines the block.

In response to applicant's arguments, the recitation "an earthquake resistant structure" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In sections C-G and K, the appellant argues the intended use of the block and the location of the aggregate, etc. The examiner has addressed these arguments above. Therefore, the examiner will not repeat the same responses here.

In section H, the appellant argues that Kirkpatrick addresses problems and functions that are foreign to those of the appellant's invention. The examiner would like to point out that both inventions are drawn to a concrete block having aggregate embedded in a surface of said block. Therefore, since both Kirkpatrick and the claimed invention have the same limitations, they will obviously be capable of performing the same functions. Once again, the applicant is only claiming a single block. As stated above, a single block could have hundreds of uses. The use does not define the block. The structure does, (emphasis added).

In regard to section I, the appellant argues that the examiner has their personal opinion to interpret the claims. As pointed out above in the rejections and remarks, the examiner has made

Art Unit: 3635

it quite clear that he is not relying on his personal opinion. The examiner is relying on the disclosure and drawings of Kirkpatrick's invention as well as what is notoriously well known in the art. The examiner has not made any reference to his personal opinion of the Kirkpatrick reference.

In regard to section J, the appellant argues that the examiner used hindsight to reject the claims. In response to this argument, the examiner would like to point out that, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Therefore, since the examiner did not rely on anything that was not shown or disclosed in Kirkpatrick's invention, the examiner did not rely on hindsight. The examiner merely examined the claims by giving them their broadest possible interpretation.

In conclusion, the examiner contends that claims 1, 8-13, and 10 are properly rejected in view of Kirkpatrick.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031. The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3635

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B.G. *B.G.*

March 24, 2004

Conferees:

C.F. *CF*

P.C. *R*

BRIAN E. GLESSNER
PRIMARY EXAMINER